



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/694,475

10/27/2003

Allan M. Tereba

016026-9043

4550

23510 7590 05/01/2009
MICHAEL BEST & FRIEDRICH LLP
ONE SOUTH PINCKNEY STREET
P O BOX 1806
MADISON, WI 53701

EXAMINER

GROSS, CHRISTOPHER M

ART UNIT

PAPER NUMBER

1639

MAIL DATE

DELIVERY MODE

05/01/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

ADVISORY ACTION

Continuation of 11

Maintained Claim Rejections - 35 USC § 102

Claims 44,45,50,53,66,67,82 are rejected under 35 U.S.C. 102(b) as being anticipated by **Melzak et al** (1996 J. Colloid and Interface Science 181:635-644) as evidenced by information available at <http://seq.yeastgenome.org/> for the reasons set forth in the office action mailed 11/18/2008.

Response to Arguments and Comments

On p 7 second paragraph the remarks entered 2/17/2009, applicant questions the need for the DNA sequence of PUC18 provided at <http://seq.yeastgenome.org/> (provided as reference V in the PTO-892 mailed 11/18/2008). In this regard, applicant attention is respectfully invited to the last office action on p 8 which indicates that pUC18 contains short tandem repeats such as CGCGCG, which read on claim 67.

On p 7 fourth paragraph of the remarks entered 2/17/2009, applicant argues that Melzak et al is not concerned with isolating a consistent amounts of DNA from multiple samples having DNA in excess of the binding capacity but rather the research described therein was undertaken to study the dominant driving forces involved in DNA adsorption to silica in perchlorate solutions. In this regard the examiner notes that even though the goal of the study is different from applicant's that does not change the fact that Melzak et al, based on the quantitative desorption of pUC18 from silica shown in figure 3B, does indeed isolate consistent amounts of DNA from multiple samples with DNA in excess of the binding capacity as shown in the flat portion of the titration curve.

Maintained Claim Rejections - 35 USC § 103

Claims 44,45,50,53,65,67,82 and 46-49,51-52,54,58,60-64,68,77-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Melzak et al** (1996 J. Colloid and Interface Science 181:635-644) in view of **Kleiber et al** (WO 96/41811 – IDS entry 1/8/2007) for the reasons set forth in the office action mailed 11/18/2008.

Response to Arguments and Comments

On p 8 first full paragraph of the remarks entered 2/17/2009, applicant seems to assert Kleiber et al in view of Huber being withdrawn indicates the reference is no longer relevant. In this regard, applicant's arguments entered 10/31/2007 regarding Kleiber et al treating identical samples identically were deemed persuasive, thus the need for the new reference to Melzak et al who teach multiple samples.

Other than that, applicant does not offer further arguments regarding the above obviousness rejections beyond what was set forth with regard to the 35 U.S.C. § 102 rejection, above. To the extent that Applicant is merely repeating their previous argument, the Examiner contends that those issues were adequately addressed in the above sections, which are incorporated in their entireties herein by reference

Claims 69-70,72-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Melzak et al** (1996 J. Colloid and Interface Science 181:635-644) in view of **Kleiber et al** (WO 96/41811 – IDS entry 1/8/2007) as applied to claims 44,45,50,53,65,67,82 and 46-49,51-52,54,58,60-64,68,77-81 above, and further in view

Art Unit: 1639

of **Ryder et al** (US Patent 5639599) for the reasons set forth in the office action mailed 11/18/2008.

Response to Arguments

On p 8 first full paragraph of the remarks entered 2/17/2009, applicant questions the relevance of Ryder. In this regard, it is noted that Ryder teach a kit, which is not taught by Melzak et al in view of Kleiber , as mentioned in the last office action on p 12, second full paragraph. It is further noted the kits recited in the present claims are open to additional elements by using the transitional term comprising. Accordingly the iron complexing agent kits of Ryder et al are relevant to the patentability of the present subject matter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER M. GROSS whose telephone number is (571)272-4446. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on 571 272 0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher M Gross
Examiner
Art Unit 1639

cg

/ Christopher S. F. Low /
Supervisory Patent Examiner, Art Unit 1636